

**REMARKS**

Pursuant to the present amendment, claims 1, 7, 9, 24, 29, 30, 38, 40 and 41 have been amended, claims 6, 27, 28, 31 and 39 have been canceled, and new claims 52-62 have been added. Thus, claims 1-5, 7-26, 29-30, 32-38 and 40-62 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

On April 15, 2005, the undersigned and Examiner Waks discussed the Office Action issued in this case. More specifically, one issue discussed was whether or not claim 23 was allowable. On page 7 of the Office Action, claim 23 is rejected, whereas on page 10, claim 23 is stated to be allowable. Examiner Waks confirmed that claim 23 is allowable, and that the rejection of claim 23 set forth on page 7 was an inadvertent error. Another issue that was discussed was whether claim 32 was rejected, as it is not specifically addressed in the Office Action. Examiner Waks confirmed that claim 32 stands rejected.

A Supplemental Information Disclosure Statement (IDS) is being filed with the present response. The Supplemental IDS lists the patents discussed in the background section of the application. Consideration of the references cited on the Supplemental IDS is respectfully requested.

Also submitted herewith is U.S. Patent No. 6,729,130, which is a United States counterpart to Norwegian Patent NO 309737 B1. Applicants respectfully request consideration of U.S. Patent No. 6,729,130.

The Examiner also objected to the drawings submitted with the patent application. Submitted herewith are formal drawings for the application that are believed to render the examiner's rejections moot. Withdrawal of the objection to the drawings is respectfully requested.

The Examiner also objected to the Abstract submitted with the application. Submitted herewith is a new Abstract that is believed to overcome the Examiner's objection. Withdrawal of the objection regarding the Abstract is respectfully requested.

In the Office Action, claim 24 was rejected under 35 U.S.C. § 112 due to an alleged lack of enablement. Claim 24 has been amended in a manner believed to overcome the § 112 rejection. More specifically, claim 24 has been amended to recite that the at least one stationary magnet comprises stator windings. Support for the newly added language can be found in the specification at, for example, page 15, line 19 – page 16, line 6. Withdrawal of the § 112 rejection of claim 24 is respectfully requested.

In the Office Action, claims 6-14, 16, 23, 28, 29, 31, 35, 39-45 and 49-51 were indicated to be allowable if rewritten in independent form. Pursuant to the present amendment, independent claims 1, 24, 30 and 38 have been amended to include the limitations from now-canceled dependent claims 6, 28, 31 and 39, respectively. Accordingly, it is respectfully submitted that claims 1-5, 7-26, 29-30, 32-38 and 40-51 are in condition for immediate allowance.

New independent claims 52, 53, 56 and 57 have been added to re-present original dependent claims 10, 12, 16 and 35, respectively, in independent form. Thus, it is respectfully submitted that new claims 52-57 are likewise in condition for immediate allowance.

In the Office Action, claims 1, 2, 38 and 46 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Stone (U.S. Patent No. 3,373,806). Claims 1-3, 15, 17-20, 30, 38 and 46-48 were rejected as allegedly being anticipated by Abramov (U.S. Patent No. 6,460,936). Claims 4 and 5 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Abramov in view of Tubel (U.S. Patent No. 5,839,508). Claim 21 was rejected under 35 U.S.C. 103 as allegedly being obvious over Pearson (GB 2266546) in view of Koshmal (EP 1106777).

Claims 21, 22 and 23 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Abrmov in view of Skoblo (WO 99/39080). Claim 24 was rejected as being unpatentable over Stone in view of Jurgens (U.S. Patent No. 4,415,823). Claims 30, 33, 36 and 37 were rejected under 35 U.S.C. § 103 as allegedly being obvious in view of Pearson and Abramov. Claim 34 was rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Pearson in view of Abramov and Skoblo.

It is believed that the above-identified rejections of original claims 1-51 is moot in view of the amendments described above. Of course, in making the present amendments, Applicants do not acquiesce in the correctness of the Examiner's rejections.

Submitted herewith are new claims 58-59 which are allowable over the prior art of record, as described more fully below. New claim 58 is directed to a subsea system comprised of a subsea installation positioned adjacent a floor of a body of water, the subsea installation comprising at least one production flowline and a turbine positioned above the floor of the body of water and below a surface of the body of water, the turbine being operatively coupled to the production flowline, the turbine being rotatable by production fluid flowing through the production flowline, the turbine generating electrical power output when the turbine is rotated by the production fluid. It is respectfully submitted that such a system is allowable over the prior art of record.

Stone is directed to a method and apparatus for drilling and completing oil and gas wells. Col. 1, ll. 8-11. Stone discloses a Christmas tree 46 positioned adjacent a conductor pipe 14 of a well. Figure 3. Stone also discloses the use of a snorkel tube 44 and associated support 32 to complete the well. Col. 3, ll. 7-24. A flowline 62 extends upwardly from the wellhead through the snorkel tube 44 above the water line 64. Col. 4, ll. 45-49; Figure 3. Flowline 62 continues upwardly to a separator unit 68. A turbine 72 is mounted above the separator unit 68. Col. 4, ll.

55-59. The turbine 72 is adapted to supply electricity for a foghorn and light unit 76 mounted on top of the snorkel tube 44. A vent tube is provided in the top of the snorkel tube 44 to vent undesirable gases.

From the foregoing, it is clear that Stone does not anticipate new independent claim 58 for at least the reason that the turbine 72 in Stone is not positioned above the floor of the body of water and below the surface of the body of water. That is, the turbine 72 in Stone is located above the surface of the water 64.

Abramov is understood to be directed to a borehole mining tool that employs pressurized water to loosen the material to be mined. Abstract. To that end, Abramov discloses that a turbine 302 is positioned adjacent the end of the tool. See Figure 14. As with Stone, Abramov does not anticipate independent claim 58 for at least the reason that the turbine 302 disclosed therein is not positioned above the floor of the body of water and below the surface of the body of water as recited in claim 58. In Abramov, the turbine is positioned in a subterranean wellbore.

Tubel also does not anticipate new independent claim 58. Tubel is directed to an electrical generating apparatus that is connected to production tubing. Abstract. The device described in Tubel is positioned within the casing 12 of a well 10, i.e., it does not anticipate claim 58 for at least the reason that the turbine disclosed therein is not positioned above the floor of the body of water and beneath the surface of the body of water.

Claim 58 is likewise not anticipated by Pearson. Pearson is generally directed to a remote control apparatus for controlling underwater arrangements, such as subsea wellheads. Page 1, ¶ 1. In the device disclosed in Pearson, pressurized gas from a source 3 on an offshore platform 1 is supplied to the subsea installation via a conduit 8 and manifold/distributor 11. Abstract; Page 4, ¶ 2. Conduit 12 is used to supply pressurized gas to the two-stage turbine 13. Abstract; Page 4, ¶ 4. The supply conduit 12 has a coil arrangement 36 wound around a flowline

31 prior to entering the first stage of the turbine 13. Thus, the pressurized gas supplied to the turbine 13 is heated via the coil 36 by the hot product flowing through the flowline 31. A similar coil arrangement 38 is provided with conduit 37 to heat pressurized gas prior to the second stage of the turbine 13.

Pearson does not anticipate new independent claim 58 for at least the reason that the turbine in Pearson is not operatively coupled to a production flowline and the turbine in Pearson is not rotatable by production fluid that flows through a production flowline, as recited in claim 58. In Pearson, production fluid does not cause the turbine 13 to rotate. Rather, only pressurized gas (supplied from the surface) flows through the turbine 13. Thus, Pearson does not anticipate new independent claim 58.

Moreover, new independent claim 58 is not obvious in view of the prior art of record. As the Examiner well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

In this case, the prior art of record simply does not provide any suggestion or motivation to modify the prior art so as to arrive at Applicants' invention. In *Stone*, there is simply no motivation to move the turbine disclosed therein from its location positioned above the surface of the water. Apparently, *Stone* was motivated to use the turbine described therein to supply electrical power to surface devices such as the foghorn and light assembly disclosed therein. Thus, there does not appear to be any motivation to move the turbine away from the above water line location described in *Stone*. In *Abrmov* and *Tubel*, there is likewise no motivation to move the turbines located downhole to a position above the floor of a body of water but below the surface of the body of water. The turbines disclosed in those patents are positioned downhole for the reasons set forth in those patents. There is simply no motivation in the art of record to move the turbines disclosed in *Abrmov* and *Tubel* to any location other than a downhole location.

The present invention is also not obvious in view of Pearson, when considered individually or in combination with any other art of record. Although Pearson does disclose a turbine 13 positioned above the floor of the body of water and below the surface of the body of water, the turbine 13 in Pearson is not operatively coupled to a production flowline such that it is rotated by production fluid flowing through the production flowline. Only pressurized gas is supplied to the turbine 13 via the conduits 8, 12 and the manifold 11. If anything, Pearson teaches away from the present invention in that Pearson employs a rather elaborate system to supply pressurized gas to drive the turbine as opposed to operatively coupling the turbine 13 to the flowline 31 and using production fluid flowing through the flowline 31 to drive the turbine 13. Simply put, if the present invention was obvious, why didn't Pearson's device employ the present invention as set forth in claim 58? Certainly, it would have been a much simpler system and at least some of the surface components on the platform could have been eliminated. Thus, Pearson would have been motivated to adopt the presently claimed invention if it had been obvious.

It is respectfully submitted that any attempt to assert that the invention defined by new independent claim 58 would have been obvious in view of the prior art of record necessarily involves an improper use of hindsight using Applicants' disclosure as a roadmap. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Thus, it is respectfully submitted that new independent claim 58 and dependent claim 59 are in condition for immediate allowance.

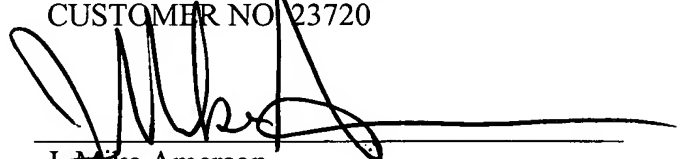
New independent claim 60 is likewise believed to be allowable over the prior art of record. New claim 60 is a specific example of the present invention wherein the turbine is operatively coupled to an injection fluid flowline, and the turbine is rotatable by the injection fluid flowing through the injection fluid flowline to thereby generate electrical power.

It is respectfully submitted the new independent claim 60 and dependent claims 61-62 are likewise allowable for at least the reasons set forth above with respect to claim 58.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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